REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested in light of the above-marked amendments and the foregoing remarks. The Examiner is encouraged to contact the undersigned at +1.858.314.1535 or cakukkonen@mintz.com to discuss this Response.

Rejection under 35 U.S.C. § 101

Claims 132-142 stand rejected under 35 U.S.C. § 101 because allegedly the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed as follows.

For allowability under 35 U.S.C. § 101, the Office requires hardware components to be associated with the claimed plurality of sequential modules, as noted on pages 2 and 3 of the Office Action. Accordingly, claim 132 has been amended to recite the following limitation: "wherein each module of the plurality of sequential modules is implemented by at least one data processor of one or more computing systems." It is respectfully submitted that this amendment obviates the basis of the rejection. Therefore, the rejection under 35 U.S.C. § 101 of claim 132, as well as claims 133-142, at least by reason of their dependency, should be withdrawn.

Rejections under 35 U.S.C. §103(a)

Claims 78-80, 84, 85, 87-97, 99-107, 111, 112, 114-124 and 126-142 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0069869 to Gronau et al. (hereinafter "Gronau") in view of U.S. Patent No. 6,411,936 to Sanders (hereinafter "Sanders") and U.S. Patent Application Publication No. 2004/0039619 to Zarb (hereinafter "Zarb"). Claims 98 and 125 stand rejected under 35 U.S.C. §103(a) as

allegedly being unpatentable over Gronau in view of Sanders, Zarb, and U.S. Patent Application Publication No. 2002/0147626 to Zagotta et al. (hereinafter "Zagotta"). These rejections are respectfully traversed.
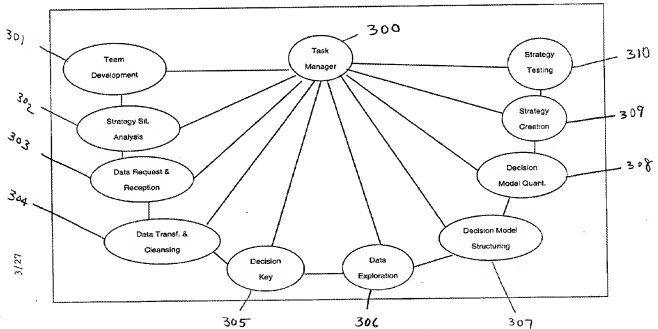
For a proper rejection under 35 U.S.C. §103(a), the Office "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness" and must therefore present "a clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP §2142. An obviousness rejection "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP §2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. MPEP §2141.02 further notes that "a prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The rejections over the cited references fail to satisfy this burden with regards to the currently pending claims.

Claim 78 recites, inter alia, the following feature: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the

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predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules."
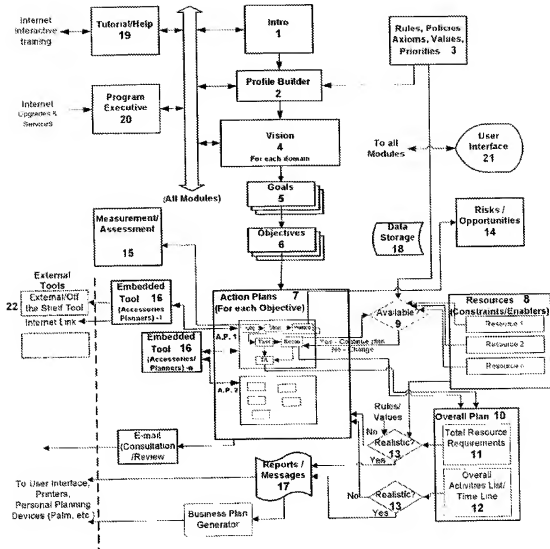
Claim 78 requires a plurality of modules including a team development module, strategy situation module, data request and reception module, data transformation and cleansing module, decision key and intermediate variable module, data exploration module, decision model structuring module, decision model quantification module, strategy creation module, and strategy testing module. See original application at least at Fig. 3 (shown below), TABLE C, and associated text. As noted in the original application at Fig. 3, the plurality of modules occur in a *sequence* such that each module *occurs once* and that output of each module is an input of the next module until control is passed to the last module (e.g. strategy testing module 310). Emphasis added.

Fig. 3

Original application at Fig. 3

In contrast to claim 78, Gronau describes an enterprise performing a series of steps 1-22 on an application to perform strategic planning by using a strategy plan. For example, see Gronau at FIG. 1 (reproduced below). The strategy plan constitutes optimum allocation of resources available in a resource database. To perform the strategic planning, the enterprise uses a profile builder to create a profile of the enterprise on the application. The profile consists of current financial information of the enterprise. Then, the enterprise defines rules (including policies, axioms, values and priorities) that need to be used to achieve the objectives. The defining of the rules includes either (a) selecting the rules out of a predefined rules database, or (b) creating the rules, adding the created rules to the rules database, and selecting the added rules out of rules stored in the rules database. Subsequent to the above-mentioned defining of the rules, the enterprise defines, using the defined rules, objectives that need to be achieved. Based on the objectives, the available resources are assessed and allocated according to each corresponding objective. A measurement and assessment function keeps a track of status of activities and achievement of the objectives in the strategy planning process.

Gronau at FIG. 1

In the "Response to Arguments" section on pages 19 and 20 of the Office Action, the Office relies on subject matter of original application at paragraph 61 (reproduced below) for justifying alleged reliance on Gronau for the following feature of claim 78: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the

predetermined sequence interacts with an expert task manager, wherein said expert task manager

provides expert knowledge about strategy modeling processes to the modules."

> **[0061]** It should be appreciated that various implementations of the
> invention herein are not required to use all of the ten main modules. Nor are
> various implementations required to interact with the Task Manager module **300**.
> The particular modules implemented, and their sequence of implementation
> depends on the problem being solved by the user. The claimed invention is
> flexible to allow all variations.

<div align="center">Original application at paragraph 61</div>

Claim 78 requires the use of all claimed modules. The Office appears to implicitly

acknowledge that Groneau fails to disclose or suggest the use of all claimed modules, as recited

in claim 78. To provide a basis for reliance on Groneau despite the above-noted

acknowledgement, the Office relies on original application at above-reproduced paragraph 61.

However, it is respectfully submitted that the Office has inaccurately interpreted some features of

claim 78, at least for the reasons that follow. The original application at paragraph 61 describes

some implementations other than the claimed implementation, which necessitates the use of all

the claimed modules. It is respectfully submitted that the Office is required to determine

patentabilty based on all words recited in the claims[1], rather than on subject matter in the

original application that is not claimed. Therefore, a mere reliance by the Office on unclaimed

implementations described in the original application at above-reproduced paragraph 61 is

completely incorrect. As per the reasons noted above, Groneau cannot possibly be relied-upon

for the above-referred feature of claim 78.

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[1]   All words in a claim must be considered in judging the patentability of that claim against the prior art. *In
re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, if the cited references fail to disclose or
at least fairly suggest each specific and explicit limitation of the claimed subject matter, the Office can present a
valid *prima facie* case for obviousness under 35 U.S.C. §103 only by presenting a convincing line of reasoning as to
why one of ordinary skill in the art at the time of conception of the instantly claimed subject matter would have
found the claimed invention to have been obvious in light of the teachings of the references. See *e.g.* MPEP
§706.02(j) citing *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Further, throughout the Office Action, the Office asserts that Gronau's steps 1-22 (as noted above with respect to Gronau at FIG. 1) constitute the modules recited in claim 78. However, it is submitted that the amendment to claim 78 obviates the basis of this assertion, at least in view of the reasons that follow.

The Office relies on Gronau's assessment of available resources (steps 3 and 8) for the claimed team development module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy situation analysis module, relies on Gronau's defining and assessment of rules (steps 3 and 8) for the claimed data request and reception module, relies on Gronau's defining of rules (step 3) for the claimed data transformation and cleansing module, relies on Gronau's defining of rules (steps 3) for the claimed decision model quantification module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy creation module, and relies on Gronau's tracking status of activities by measurement/assessment function (step 15) for the claimed strategy testing module. Thus, the Office relies on the steps of Gronau at FIG. 1 in a random order rather than in the order of steps from step 1 to step 22, as shown by Gronau at FIG. 1. On the contrary, amended claim 78 requires that all modules occur in a *predetermined sequence* (e.g. sequence shown by original application at Fig. 3 shown above) such that *until a last module of the sequence is reached, output of each module is an input to the next module*. Emphasis added. However, the Office relies on Gronau's modules in a random order, which obviates the possibility of an output of each module to be an input to the next module in a predetermined sequence, as necessitated by claim 78. Therefore, Gronau cannot possibly be relied upon for the following elements of claim 78: "wherein output of each module of the predetermined sequence is an input of a next module

in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence."

Further, the Office relies on same steps of Gronau for multiple modules claimed separately. As one example, the Office relies on Gronau's step 3 for at least the claimed team development module, the claimed request and reception module, and the claimed decision model quantification module. However, claim 78 necessitates that *each module in the sequence occurs once* (e.g. see original application at Fig. 3 shown above), rather than a particular step (which has been relied upon for a module) being repeated multiple times, as taught by Gronau. Emphasis added. For at least this reason, Gronau fails to cure the following elements of claim 78: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence."

As per the reasons noted above, it is completely incorrect to rely on Gronau's steps for the modules required by claims 78.

In view of the foregoing, Gronau fails to disclose or suggest the following feature of claim 78: "each module of the plurality of modules occurring in a predetermined sequence of the plurality of modules such that each module occurs once in the predetermined sequence, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules."

Further, the Office acknowledges on pages 5 and 6 of the Office Action that Gronau fails to disclose or suggest the claimed decision key and intermediate variable creation module 305

(see original application at Fig. 3 shown above), and the claimed data exploration module 306. To cure these deficiencies of Gronau, the Office relies on Sanders and Zarb. However, this reliance is respectfully disagreed-upon as follows.

To begin with, Sanders and Zarb, whether taken individually or in combination, fail to cure the above-noted deficiencies of Gronau.

Further, claim 78 requires that that all modules occur in a predetermined sequence (e.g. sequence shown by original application at Fig. 3 shown above) such that until a last module of the sequence is reached, output of one module is an input to the next module. Accordingly, for an appropriate combination of Gronau with Sanders, the Office needs to show that the output of a module (e.g. data transfer and cleansing module 304) prior to the decision key and intermediate variable creation module 305 should be similar to input to the relied-upon alleged module in Sanders. Furthermore, for an appropriate combination of Gronau, Sanders and Zarb, the Office needs to show that the output of a module (e.g. decision key module 305) prior to the data exploration module 306 should be similar to input to the relied-upon alleged module in Zarb. However, it is believed that the Office has failed to provide the above-noted showings for an appropriate combination of Gronau, Sanders, and Zarb. Therefore, it is incorrect to combine Gronau, Sanders, and Zarb for rejecting the features of claim 78.

In view of at least the reasons noted above, it is respectfully submitted that that a *prima facie* case for obviousness has not been established and claim 78 should be in condition for allowance. Therefore, claim 78 is allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 78, as well as claims 79, 80, 84, 85, 87-97, and 99-104, at least by reason of their dependency, should be withdrawn.

Independent claims 105 and 132 recite features similar to those noted above with respect to claim 78. Therefore, claims 105 and 132, as well as claims 106, 107, 111-112, 114-124, 126-131, and 133-142, at least by reason of their dependency, are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Moreover, it is submitted that Gronau, Sanders, and Zarb, whether taken individually or in combination, fail to disclose or suggest the subject matter of claims 133-142, as supported by the original application, at least at TABLE C, Fig. 3, and associated text. It appears that the Office has incorrectly relied on merely one element of Gronau at paragraph 52 for all the separate features recited in claims 133-142. For this additional reason, claims 133-142 are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Claim 98 depends from claim 78 and includes all the features recited therein. Further, it is submitted that Zagotta fails to cure the above-noted deficiencies of Gronau, Sanders, and Zarb. Accordingly, claim 98 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 98 should be withdrawn for at least this reason.

Claim 125, although of different scope, includes features similar to those noted above with respect to claim 98. Therefore, claim 125 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 125 should be withdrawn for at least this reason.

Conclusion Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-556F01US.

Respectfully submitted,

Date: December 15, 2011

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